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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,220	04/14/2006	Eng Sia Lee	1823.010	6995
23598 7590 12/22/2008 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203				
EXAMINER BATISTA, MARCOS				
ART UNIT 2617		PAPER NUMBER		
NOTIFICATION DATE 12/22/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

### Office Action Summary

**Application No.**

10/576,220

**Applicant(s)**

LEE ET AL.

**Examiner**

MARCOS BATISTA

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 19-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-35, and 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/07/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 19, 37, and 42 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 4-7, 9-17, 19, 20, 22-25, 27-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Kuwabara (US 20050099997 A1), hereafter "Kuwabara."

Consider claim 1, Dowden discloses a messaging-enabled communications device configured for a roaming-free connection to a mobile telephone services provider (**see abstract, Fig 6, col. 1 lines 3-14, col. 15 lines 3-11**). Dowden also teaches a gateway being for placing a telephone call to a destination telephone having a telephone number indicated by a message received from the mobile communications device and also for placing a telephone call to the user through the service provider to patch the user to the destination telephone without incurring roaming charges (**see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13**).

Dowden discloses an SMS callback system where a message is sent to an SMS server, which then relates that information to a gateway. The gateway that connects the called and the calling parties, regardless of their respective locations, as instructed by the SMS, thus eliminating the roaming charges. Dowden, however does not particular refer to a distributor, the distributor

providing the communications device to a user or a communication device is registered with the gateway before it is provided to the user.

Chow teaches a distributor, the distributor providing the communications device to a user (see [0180] – where an electronics store provides a subscriber with a new phone). Chow also teaches a communication device is registered with the gateway before it is provided to the user (see [0180] – where a phone is registered by a salesperson upon acquiring it).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden and have it include distributor, the distributor providing the communications device to a user and a communication device is registered with the gateway before it is provided to the user, as taught by Chow. The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Dowden, as modified by Chow teaches the above mentioned feature of claim 1. Dowden, however, does not particular refer to wherein the communication device activates a fake ring-tone when the message is being received by the gateway so that the user is made to feel that the destination telephone is being dialed in the conventional way.

Kuwabara, in analogous art, teaches a communication device activates a fake ring-tone when the message is being received by a computer (see fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4 – Kuwabara teaches an IP phone system where an IP phone device 10 sends commands via an audio cable to a computer device 20 (i. e., gateway), which is connected to the Internet in order to reach an intended party)

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the invention of Dowden as modified by Chow and have it include a communication device activates a fake ring-tone when the message is being received by a computer, as taught by Kuwabara. The motivation would have been in order give the impression of the calling user that the Internet call is dial in a regular manner (see fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4).

Consider claim 2, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein the message is an SMS (see col. 14 lines 20-21).

Consider claim 4, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein the mobile communications device is a mobile telephone (see fig. 6, #8a, col. 15 lines 3-6).

Consider claim 5, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein mobile communications device is a SIM card (see col. 6 lines 16-18, col. 12 lines 4-6).

Consider claim 6, Dowden as modified by Chow and Kuwabara teaches claims 1 above. Dowden also teaches wherein the user receives the telephone call at the mobile communications device (see fig 5, col. 14 lines 4-5).

Consider claim 7, Dowden as modified by Chow and Kuwabara teaches claims 1 above. Dowden also teaches wherein the user receives the telephone call at a telephone having a telephone number indicated by the message (see fig 6, col.16 lines 11-23).

Consider claim 9, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Chow also teaches wherein the mobile communications device is provided to the user by selling it to the user (see [0180]). The motivation would have been in order to give the user the ability to

dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 10, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Chow also teaches wherein the distributor is a retail outlet (see [0180]). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 11, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein the distributor provides a selection of mobile communications devices configured for roaming free connections to different mobile telephone services providers (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13 –where Dowden teaches a gateway that connects the called and the calling parties, regardless of their respective locations, as instructed by the SMS, thus eliminating the roaming charges).

Consider claim 12, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches a database containing user identification information and billing information of the user (see fig 2 #77, col. 8 lines 3-18). Dowden also teaches an identification system for obtaining the user identification information from the message (see fig 3, col. 8 lines 16-17). Dowden further teaches a data processing system for matching the user identification information obtained from the message with the user identification information in the database to identify the user (see fig 2, fig 3, col. 8 lines 3-18).

Consider claim 13, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Chow also teaches wherein the user identification information and billing information of the user is entered into the database based on information obtained upon the user registering with the

distributor (see [0180] – where Chow teaches registering a phone with a server provider. The registration of a phone is known in the art to include the billing information of the customer). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see [0180], [0182]).

Consider claim 14, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein the user may enable a diversion of calls from another communication device to the gateway, whereby the calls may be connected to the messaging-enabled communications device (see col. 9 lines 3-9 – where Dowden teaches that the SNCP receives various service requests from the user).

Consider claim 15, Dowden as modified by Chow and Kuwabara teaches claim 1 above. Dowden also teaches wherein the distributor is located outside the service area of the mobile telephone services provider (see fig 5, col. 6 lines 7-18).

Consider claim 16, Dowden as modified by Chow and Kuwabara teaches claims 1 and 19 above. Dowden also teaches wherein the gateway is located outside the service area of the mobile telephone services provider (see fig 5, col. 6 lines 7-18).

Consider claim 17, Dowden as modified by Chow and Kuwabara teaches claims 1 and 19 above. Dowden also teaches wherein the gateway is arranged, upon receiving a first phone call from the communication device, to place a second phone call to the device and thereby initiate the sending of the message as part of the second phone call (see Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13).

Consider claims 19, 20, 22-25, and 27-35, these are method claims corresponding to system claims 1, 2, 4-7 and 9-17. Therefore, they have been analyzed and rejected based upon



the system claims 1, 2, 4-7 and 9-17 respectively.

Consider claim 37, Dowden discloses messaging-enabled enabled phone arranged to generate a menu of options, the menu comprising destination telephone numbers (see **col. 3 lines 21-22, col. 4 lines 4-5, col. 12 lines 1-11**). Dowden also teaches wherein selection of one or more of the destination numbers causing the phone to generate a message to a service provider of SMS Callback (see **col. 12 lines 1-18**). Dowden also teaches the message containing indications of the at least one of the destination numbers (see **col. 12 lines 1-18, col. 13 lines 10-19**). Dowden further teaches the message causing the service provider to place call(s) to the at least one destination number and also to place a call to the sender of the message, and patching the calls when they are connected (see **Fig 2, Fig 3, col. 8 lines 7-21, col. 9 lines 1-12, col. 13 lines 10-13**). Chow also teaches a communication device is registered with the gateway before it is provided to a user (see **[0180]** – where a phone is registered by a salesperson upon acquiring it). The motivation would have been in order to give the user the ability to dynamically create, modify or remove services instantaneously upon acquiring the phone (see **[0180], [0182]**).

Dowden, as modified by Chow teaches the above mentioned feature of claim 37. Dowden, however, does not particular refer to wherein the phone activates a fake ring-tone when the message is being received by the gateway so that the user is made to feel that the destination telephone is being dialed in the conventional way.

Kuwabara, in analogous art, teaches a communication device activates a fake ring-tone when the message is being received by a computer (see **fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4** – Kuwabara teaches an IP phone system where an IP phone device 10 sends

commands via an audio cable to a computer device **20** (i. e., gateway), which is connected to the Internet in order to reach an intended party). The motivation would have been in order give the impression of the calling user that the Internet call is dial in a regular manner (see fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4).

Consider claim 39, Dowden as modified by Chow and Kuwabara teaches claim 37 above. Dowden also teaches wherein the message is an SMS (see col. 14 lines 20-21).

7. Claims 3, 21, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Kuwabara (US 20050099997 A1), hereafter "Kuwabara," further in view of Valloppillil et al. (US 20040137921 A1), hereafter "Valloppillil."

Consider claim 3, Dowden as modified by Chow and Kuwabara teaches claims 1 and 19 above. But Dowden does not particular refer to the message is an MMS. Valloppillil teaches wherein the message is an MMS (see fig 2A, [0040]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Kuwabara and have it include the message is an MMS, as taught by Valloppillil. The motivation would have been in order to provide a message-enabled communication method between a mobile device and an SMS server (see fig 2A, [0040]).

Consider claim 21, this is a method claim corresponding to system claim 3. Therefore, it has been analyzed and rejected based upon the system claim 3 above.

Consider claim 38, Dowden as modified by Chow and Kuwabara teaches claim 37 above. But Dowden does not particular refer to message which is called up by a button in the messaging-enabled phone. Valloppillil teaches message which is called up by a button in the messaging-enabled phone (see fig 3, [0113]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Kuwabara and have it include message which is called up by a button in the messaging-enabled phone, as taught by Valloppillil. The motivation would have been in order to aid the user in composing messages (see fig 3, [0113]).

Consider claim 40, Dowden as modified by Chow and Kuwabara teaches claim 37 above. But Dowden does not particular refer to wherein the message is an MMS. Valloppillil teaches wherein the message is an MMS (see fig 2A, [0040]). The motivation would have been in order to provide a message-enabled communication method between a mobile device and an SMS server (see fig 2A, [0040]).

8. Claims 8 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Kuwabara (US 20050099997 A1), hereafter "Kuwabara," further in view of Wittstein et al. (US 5631947 A), hereafter "Wittstein."

Consider claim 8, Dowden as modified by Chow and Kuwabara teaches claims 1 and 19 above. But Dowden does not particular refer to the mobile communications device is provided to the user by renting it to the user. Wittstein teaches the mobile communications device is

provided to the user by renting it to the user (see abstract, col. 12 lines 20-28).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Kuwabara and have it include the mobile communications device is provided to the user by renting it to the user, as taught by Wittsteinet. The motivation would have been in order to provide a user with a method for acquiring a communication device (see abstract, col. 12 lines 20-28).

Consider claim 26, this is a method claim corresponding to system claim 8. Therefore, it has been analyzed and rejected based upon the system claim 8 above.

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dowden et al. (GB2342536A), hereafter "Dowden," in view of Chow et al. (US 20030185203 A1), hereafter "Chow," further in view of Kuwabara (US 20050099997 A1), hereafter "Kuwabara," further in view of Deeds (US 20040203610 A1), hereafter "Deeds."

Consider claim 41, Dowden as modified by Chow and Kuwabara teaches claim 37 above. But Dowden does not particular refer to wherein the message masks the gateway of the service provider.

Deeds teaches wherein the message masks the gateway of the service provider (see [0058]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Dowden as modified by Chow and Kuwabara and have it include wherein the message masks the gateway of the service provider, as taught by Deeds. The motivation would have been in order to prevent other users from identifying the

communication device (see [0058]).

10. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable Chow et al. (US 20030185203 A1), hereafter "Chow," in view of Valloppillil et al. (US 20040137921 A1), hereafter "Valloppillil," further in view of Kuwabara (US 20050099997 A1), hereafter "Kuwabara."

Consider claim 42, Chow teaches the messaging-enabled enabled phone is registered with a gateway before it is provided to a user (see [0180] – where a phone is registered by a salesperson upon acquiring it).

Chow teaches claim 42 above, but does not particular refer to a button wherein a message is sent to a service provider providing SMS Callback when pressed.

Valloppillil teaches message which is called up by a button in the messaging-enabled phone (see fig 3, [0113]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Chow and have it include message which is called up by a button in the messaging-enabled phone, as taught by Valloppillil. The motivation would have been in order to aid the user in composing and sending the messages to the SMS server (see fig 3, [0113]).

Chow, as modified by Valloppillil teaches the above mentioned features of claim 42, but does not particular refer to wherein the phone activates a fake ring-tone when the message is being received by the gateway so that the user is made to feel that the destination telephone is being dialed in the conventional way.

Kuwabara, in analogous art, teaches a communication device activates a fake ring-tone when the message is being received by a computer (see **fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4** – Kuwabara teaches an IP phone system where an IP phone device **10** sends commands via an audio cable to a computer device **20** (i. e., gateway), which is connected to the Internet in order to reach an intended party)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the invention of Chow as modified by Valloppillil and have it include a communication device activates a fake ring-tone when the message is being received by a computer, as taught by Kuwabara. The motivation would have been in order give the impression of the calling user that the Internet call is dial in a regular manner (see **fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042 lines 1-4**).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marcos Batista, whose telephone number is (571) 270-5209. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached at (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Marcos Batista*

/M. B./

/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617

12/05/2008